

SN 09/521,614

Page 16 of 22

REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed June 18, 2004. In the Office Action, the Examiner notes that claims 1-78 are pending and rejected. The claims continue unamended.

In view of the following discussion, Applicant submits that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Thus, Applicant believes that all of these claims are now in allowable form.

It is to be understood that the Applicant, does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

REJECTIONS**35 U.S.C. §102**

Claims 1-5, 8, 9, 12-14, 16, 19-26, 29, 30, 33-35, 37, 40-47, 50, 51, 54-56, 58, 61-65, 67-70, 72-75, and 75-78

The Examiner has rejected claims 1-5, 8, 9, 12-14, 16, 19-26, 29, 30, 33-35, 37, 40-47, 50, 51, 54-56, 58, 61-65, 67-70, 72-75 and 75-78 under 35 U.S.C. §102(e) as being clearly anticipated by U.S. Patent 6,553,178-B2 to Abecassis. The Applicant respectfully traverses the rejection.

Applicant's independent claims 1, 22, 43, and 69 recite (the remaining independent claims recite similar limitations):

"1. A method for automatically pausing a video program in response to an occurrence of an event, comprising:
receiving a video program and outputting the video program for presentation on a display device;
detecting occurrence of a communications event during the video program;
pausing the video program in response to the detection of the occurrence of the communications event; and
outputting a signal for displaying an indication of the occurrence of the communications event.

SN 09/521,614
Page 17 of 22

22. An apparatus for automatically pausing a video program in response to an occurrence of an event, comprising:
a receive module for receiving a video program and outputting the video program for presentation on a display device;
a detection module for detecting occurrence of a communications event during the video program;
a pause module for pausing the video program in response to the detection of the occurrence of the communications event;
and
an output module for outputting a signal for displaying an indication of the occurrence of the communications event.

43. A computer program product, comprising:
a computer-readable medium containing instructions for controlling a computer system to perform a method for automatically pausing a video program in response to an occurrence of an event, the method including:
receiving a video program and outputting the video program for presentation on a display device;
detecting occurrence of a communications event during the video program;
pausing the video program in response to the detection of the occurrence of the communications event; and
outputting a signal for displaying an indication of the occurrence of the communications event.

69. A system for automatically pausing a video program in response to an occurrence of an event, comprising:
a receive module for receiving a video program and outputting the video program for presentation on a display device;
a detection module for detecting occurrence of a communications event during the video program;
a display module for displaying an indication of the communications event;
a detection module for detecting a triggering event related to the communications event; and
a pause module for pausing the video program in response to the detection of the triggering event."

74. A computer program product, comprising:
a computer-readable medium containing instructions for controlling a computer system to perform a method for automatically pausing a video program in response to an occurrence of an event, the method including:

SN 09/521,614
Page 18 of 22

receiving a video program and outputting the video program for presentation on a display device;
detecting occurrence of a communications event during the video program;
displaying an indication of the communications event;
detecting a triggering event related to the communications event; and
pausing the video program in response to the detection of the triggering event.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984)(citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). The Abecassis reference fails to disclose each and every element of the claimed invention, as arranged in the claim.

The Abecassis reference discloses an advertisement subsidized video on demand system in which, in relevant part, the user of the system may accept a communication during the use of the system and, in response to the acceptance of such communication, cause a video server transmission to be paused.

Specifically, the Abecassis reference (see, e.g., FIG. 13, reference 1311 and column 52, line 18+) discloses an "acceptance" procedure that is invoked in response to a received communication, wherein a user must affirm an acceptance of the received communication within a prescribed period of time. Only after "acceptance" is there any pausing of content. By contrast, the claimed invention pauses a video program in response to the detection of a communication.

Therefore, since the claimed step of "pausing...In response to the detection..." is not taught by the Abecassis reference, the invention of claim 1 is patentable under 35 U.S.C. §102 over Abecassis. Moreover, it is noted that independent claims 22, 43, 69, and 74 include a substantially similar limitation to that discussed above with respect to claim 1. As such, the Applicant submits that independent claims 1, 22, 43, 64, 69 and 74 are not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Furthermore, the independent claims including claims 2-5, 8, 9, 12-14, 16, 19-21, 23-26, 29, 30, 33-35, 37, 40-42, 44-47, 50, 51, 54-56, 58, 61-63, 65,

SN 09/521,614
Page 19 of 22

67-68, 70, 72-73, 75, and 77-78 depend, either directly or indirectly, from Independent claims 1, 22, 43, 64, 69 and 74 and recite additional features thereof. As such and at least for the same reasons as discussed above, Applicant submits that these dependent claims are also not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

35 U.S.C. §103

Claims 6, 7, 15, 17, 18, 27, 28, 36, 38, 39, 48, 49, 57, 59, 60, 66, 71 and 76

The Examiner has rejected claims 6, 7, 15, 17, 18, 27, 28, 36, 38, 39, 48, 49, 57, 59, 60, 66, 71 and 76 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner has rejected claims 6, 7, 15, 17, 18, 27, 28, 36, 38, 39, 48, 49, 57, 59, 60, 66, 71 and 76 as being unpatentable over Abecassis. Applicant respectfully traverses the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Abecassis reference fails to teach or suggest the Applicant's Invention as a whole.

Specifically, the Abecassis reference (see, e.g., FIG. 13, reference 1311 and column 52, line 18+) discloses an "acceptance" procedure that is invoked in response to a received communication, wherein a user must affirm an acceptance of the received communication within a prescribed period of time. Only after "acceptance" is there any pausing of content. By contrast, the claimed invention pauses a video program in response to the detection of a communication.

The various claims rejected under 35 U.S.C. §103 are dependent, either directly or indirectly, from the independent claims discussed above with respect to the §102

SN 09/521,614
Page 20 of 22

rejection. As such, all of these dependent claims are patentable for at least the reasons discussed above with respect to the 35 U.S.C. §102 rejection.

Claims 10-11, 31, 32, 52 and 53

The Examiner has rejected claims 10-11, 31, 32, 52 and 53 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner has rejected claims 10-11, 31, 32, 52 and 53 as being unpatentable over Abecassis in view of U.S. Patent 6,349,410 to Lortz. The Applicant respectfully traverses the rejection.

The Lortz reference does not bridge the substantial gap between the Abecassis reference and the Applicant's invention. Specifically, the Lortz reference discloses an integrating broadcast television pause and web browsing arrangement. Specifically, the Lortz arrangement addresses the coordination of displaying incoming signal stream including URLs and web imagery associated with the URLs. For example, as noted in column 3, final full paragraph:

"When the user wants to access web content reference by the most recent URL, the user in one embodiment presses the forward button 26 on their remote control. At block 42, the set top device receives the forward signal from the remote control. This causes the set top device to pause or display of the signal stream currently being received at block 44, while continuing to save the incoming signal stream on the storage device. The set top device then obtains the web content for the most recently stored URL from the appropriate web server at block 46."

That is, the user affirmatively decides to pause the signal stream and retrieve a web page, such affirmation being indicated by the pressing of a forward button 26 on the remote control. Thus, the Abecassis reference and the Lortz reference, either singly or in any optimal combination, fail to disclose or suggest at least the claim step of (per claim 1): "pausing the video program in response to the detection of the occurrence of the communications event."

As such claim 1 is patentable over any combination of a set of references. Moreover, the remaining independent claims also include the same relevant limitation and are therefore patentable. Finally, each of the dependent claims depends either directly or indirectly from one of the independent claims and, therefore, includes the same relevant limitation. As such, all of the claims pending are patentable for the set of

SN 09/521,614
Page 21 of 22

references. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

OFFICIAL NOTICES

The office action takes numerous official notices. See, for example, pages 4 and 5 of the Office Action. Applicant hereby traverses each official notice. Applicants respectfully request the Examiner to produce documental proof to substantiate each official notice. See M.P.E.P., §2144.03 (when relying on common knowledge in the art or "well-known" in the art, the Examiner should site a reference in support of his/her position if the Applicant traverses such an assertion).

SN 09/521,614
Page 22 of 22

CONCLUSION

Thus, Applicant submits that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 10/15/04



Eamon J. Wall
Registration No. 39,414
Attorney for Applicants

MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808